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PATENT APPLICATION

Attorney Docket No.: 19036/36959

1642

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Yamamoto *et al*

Serial No.: 09/719,272

Filed: May 3, 2001

For: Antibodies Specific for
Phosphatase Subunit of LAR

Art Unit: 1642

Examiner: Davis, N.

) I hereby certify that this paper is being
) deposited with the United States Postal
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) an envelope addressed to: Commissioner for
) Patents Washington, D.C. 20231, on this
) date:

) July 18, 2001

) 

) David A. Gass

) Reg. No. 38,153

) Attorney for Applicants

**RESPONSE TO NOTICE OF
NON-COMPLIANT AMENDMENT (37 C.F.R. 1.121)**

Commissioner for Patents
Washington, DC 20231

Sir:

This is in response to a Notice of Non-compliant Amendment (37 C.F.R. 1.121) mailed June 13, 2001 (copy enclosed) in which the Patent Office indicated that the above-identified application failed to comply with the requirements of 37 C.F.R. §1.121.

REMARKS

Applicants wish to thank Examiner N. Davis for the courteous assistance exhibited in a telephonic interview with the Applicants' representative on July 17, 2001, during which she clarified that the filing date of the amendment referred to in the Notice ("amendment filed on 5-4-01") was intended to refer to the filing date of the above-identified application. The Patent Office is reminded that 03 May 2001 is the filing date only for purposes of 35 USC §102(e), and that the filing date for all other purposes is 07 June 1999, the filing date of the international application. Examiner N. Davis further explained that the Notice was issued because the Preliminary Amendment filed on December 8, 2000 and Second Preliminary Amendment filed

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on January 12, 2001 in the above-identified application were considered non-compliant because they were not submitted in the format required under 37 C.F.R. 1.121, as amended on September 8, 2000.

The Applicants respectfully submit that the Notice was issued in error. According to 65 Federal Register 54603 of September 8, 2000, amendments in compliance with former §1.121 were accepted until March 1, 2001. After that date, amendments must comply with revised §1.121. Since mandatory compliance with the revised rule was not required until March 1, 2001, the Preliminary Amendment filed on December 8, 2000 and Second Preliminary Amendment filed on January 12, 2001 in the above-identified application have been properly submitted. There is no Patent Office rule requiring the amendments that have been filed in this case to be submitted in the revised format.

This Response has been submitted after the one month time limit (July 13, 2001) due to the delayed time caused by difficulties Examiner Davis encountered in locating the file of the above-identified application in order to respond to our request for clarification regarding the amendment referenced in the Notice (It was not possible to respond to the Notice pertaining to "The amendment filed on 5-4-01" when no amendment was filed on that date.). However, as explained above, the Patent Office rules do not require any further action for the two Preliminary Amendments to be entered and considered.

Respectfully submitted,

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July 18, 2001

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. 09719272 | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 5-4-01 is considered non-compliant because it has not been submitted in the format required under 37 CFR 1.121, as amended on September 8, 2000 (see 65 Fed. Reg. 54603, Sept. 8, 2000, and 1238 O.G. 77, Sept. 19, 2000).

- ☐ 1. The amendment does not include a clean version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(ii).
- ☐ 2. The amendment does not include a marked-up version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(iii).
- ☐ 3. The amendment does not include a clean version of the amended claim(s). 37 CFR 1.121(c)(1)(i).
- ☐ 4. The amendment does not include a marked-up version of the amended claim(s). 37 CFR 1.121(c)(1)(ii).
- ☐ 5. Other _____

☒ **PRELIMINARY AMENDMENT:** Unless applicant re-submits the preliminary amendment in compliance with revised 37 CFR 1.121 within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

For your convenience, attached to this correspondence is a copy of an informational flyer (MPEP Bookmark Bulletin on "Simplified Amendment Practice").

Legal Instruments Examiner